

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

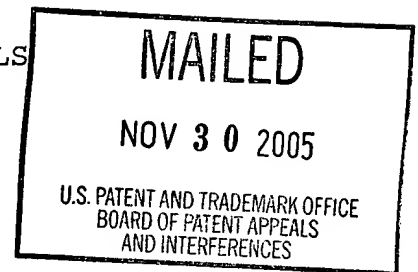
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. MERILL

Appeal No. 2005-2305
Application 09/115,359

ON BRIEF



Before HAIRSTON, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 33-52, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for responding to a computer user's inputs to a

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computer. More particularly, the invention relates to a software object in an object oriented programming environment which responds to both spoken and non-spoken command information.

Representative claim 33 is reproduced as follows:

33. A method for responding to user inputs to a computer comprising:

providing a single software object that receives both spoken and non-spoken command information;

firing an event when said object receives spoken command information; and

firing an event when said object receives non-spoken command information such that the same object can handle both spoken and non-spoken command information.

The examiner relies on the following references:

Hashimoto et al. (Hashimoto)	5,632,002	May 20, 1997
Trower, II et al. (Trower)	5,983,190	Nov. 09, 1999
		(filed May 19, 1997)

Claims 33-52 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Trower. Claims 33-52 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Hashimoto taken alone.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on

appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support either of the examiner's rejections. Accordingly, we reverse.

We consider first the rejection of claims 33-52 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Trower. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). These claims will stand or fall together as a single group as

designated by appellant [brief, page 8].

With respect to representative, independent claim 33, the examiner has indicated how he finds the claimed invention to be met by the disclosure of Trower [answer, pages 4-5]. Appellant argues that Trower does not teach a single software object that receives both spoken and non-spoken command information. Appellant argues that although the system in Trower responds to spoken and non-spoken commands, Trower does not disclose a single software object for performing this function [brief, pages 8-10]. The examiner responds that Res judicata applies because the definition of an object was decided in the previous appeal in this case [Appeal No. 2001-2630]. The examiner also argues that the claimed single software object is met by Trower's agent object [answer, pages 9-11]. Appellant responds that the claimed software object cannot be read on the system of Trower. Appellant reasserts that there is no single software object in Trower that fires an event for both spoken and non-spoken commands [reply brief, pages 1-5].

We will not sustain the examiner's rejection of claims 33-52 as anticipated by Trower. The examiner's position that Res judicata applies to this rejection is incorrect. The finding made in our previous decision was that Trower disclosed an

element that met the claimed invention. We held that appellant's attempt to argue that the system of Trower was not a software object in the Request for Rehearing to be untimely filed. Thus, appellant's arguments as to why the system of Trower did not meet the claim recitation of a "software object" were not considered in our previous decision. Those arguments are properly before us in this appeal. We find that Trower merely teaches that his system can receive spoken and non-spoken commands. We can find no disclosure, however, that these commands are received by a single software object as claimed. Although Trower teaches that a single object can perform several functions and can support more than one interface, there is no disclosure that the two particular functions recited in claim 33 are received by a single software object. Since the rejection is based on anticipation and not obviousness, we must conclude that Trower fails to disclose every element of the claimed invention.

We now consider the rejection of claims 33-57 under 35 U.S.C. § 103 based on Hashimoto. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the

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factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re

Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has explained how he finds the invention of representative claim 33 to be obvious over the teachings of Hashimoto [answer, pages 7-8]. Appellant made no response to this rejection in the appeal brief. Although the examiner notes that appellant did not respond to this rejection, the examiner responds that SIM 104 of Hashimoto corresponds to the single software object of claim 33 [answer, pages 11-12]. Appellant responds that there is no basis for a single reference Section 103 rejection. Thus, appellant argues that the examiner has failed to establish a prima facie case of obviousness and appellant, therefore, has no duty to further respond. Appellant then proceeds to argue the merits of the examiner's position with respect to the rejection [reply brief, pages 5-7].

New rules governing proceedings before the Board of Patent Appeals and Interferences went into effect on September 13, 2004. Appellant's main brief was filed under the old rules. Under the old rules, appellant's failure to respond to this rejection would be grounds for affirming the rejection. Appellant's reply brief was filed under the new rules. The new rules provide that arguments included in the brief or reply brief filed pursuant to § 41.41 will be considered [37 CFR § 41.37(c)(1)(vii)]. Therefore, under the new rules, we will consider this rejection on the merits.

We will not sustain the examiner's rejection of claims 33-52 as being unpatentable over Hashimoto. The examiner has identified SIM 104 of Hashimoto as meeting the claimed single software object. As recited in representative claim 33, the single software object receives both spoken and non-spoken command information. SIM 104, as shown in Figure 96 of Hashimoto, receives speech input from Speech I/O System 1A and converts this speech input into equivalent mouse and keyboard inputs by way of Message Conversion Unit 143. However, there are no mouse and keyboard inputs which are input to SIM 104. Mouse and keyboard inputs are only output from SIM 104. Thus, although speech inputs in Hashimoto are made to appear the same as mouse

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